

REMARKS

The Office Action mailed November 26, 2003 has been reviewed and carefully considered.

Claim 14 has been amended. No new matter has been added. Claims 1-21 are pending in this application.

By the Office Action, Claims 10-13 stand rejected under 35 U.S.C. §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicant respectfully disagrees with the rejection.

With respect to claims 10-13, the Examiner stated that there is no single integrated embodiment, which discloses directory assistance and voice mail together. The Applicant respectfully disagrees.

“It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed description”. MPEP §2163.I. Some of the claims explicitly recite a single integrated embodiment of the present invention that includes both directory assistance and voicemail services. Accordingly, the specification is further amended to now disclose, *inter alia*, “[a]ccording to yet another embodiment of the present invention, the earlier embodiments relating to directory assistance and voice mail may be combined and utilized in a single integrated embodiment. As both earlier embodiments may be implemented utilizing many common elements (e.g., such as those shown and described with respect to FIG. 1) as well as other elements shown in the FIGURES, such combining of

embodiments is readily implemented by one of ordinary skill in the related art, given the teachings of the present invention provided herein".

It is to be noted that FIG. 1 includes the elements for both directory assistance (display phone and database application 30) and voicemail services (voicemail server 16). The apparatus shown in FIG. 1 is utilized and described for both directory assistance (see, e.g., Applicants' Specification, p. 7, lines 15-28, p. 9, lines 1-3) and voicemail services (e.g., Applicants' Specification, p. 10, lines 13-20) and FIG. 1 shows all the elements in Claims 1 and 10. Moreover, the specification explicitly discloses that "[t]he embodiment employing voicemail server 16 works in much the same way as the directory services application described herein". Applicants' Specification, p. 10, lines 19-20.

It is therefore respectfully submitted that support for this combination of elements is clearly disclosed in the figures, claims, and specification and that the inventors had possession of the combination at the time the application was filed. Reconsideration of the rejection is earnestly solicited.

Claims 1-5, 8, 9, and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sylvan in view of Gerszberg et al. (hereinafter "Gerszberg").

Applicants respectfully assert that Sylvan does not disclose "a database application which includes directory information, the database application being remotely disposed relative to the telecommunication device", as recited in Claim 1. Moreover, Applicants respectfully assert that Sylvan does not disclose "initiating communication with a database application disposed in a telecommunications network from a remotely disposed telecommunication device ... the database including directory information", as recited in Claim 14.

Rather, Sylvan discloses a database that is local and proximate to the telephone station (database is on computer located at telephone station) as no communications means is shown or described with respect to a remote database or computer.

Moreover, Applicants respectfully assert Gerszberg does not cure the deficiencies of Sylvan. For example, Gerszberg does not disclose the above limitations of independent Claims 1 and 14. It is not surprising that such features are not disclosed in Gerszberg, as Gerszberg is directed to a “videophone blocker”. Accordingly, Applicants respectfully assert that Gerszberg is non-analogous art and is, thus, not applicable to a rejection of the pending claims.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143. Sylvan is directed to a method and system for searching an on-line directory at a telephone station. (Sylvan, Title). Gerszberg is directed to a videophone blocker (Gerszberg, Title). In particular, Gerszberg discloses “[a] videophone with selective privacy control of a caller’s transmitted image” (Gerszberg, Abstract).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (*see also*, MPEP §2141.03)).

Accordingly, while Sylvan is directed to providing data (directory information), Gerszberg is dissimilarly directed to BLOCKING data, and thus, teaches away

from any combination with Sylvan. That is, one seeking to provide data to a telephone user would not consult patents on blocking data to a telephone (or videophone) user, as the two concepts (providing data versus blocking data) diverge 180 degrees. There certainly would not be any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings when one reference involves providing data previously unavailable and the other reference involves blocking available data. Accordingly, Applicants respectfully assert that Gerszberg is non-analogous art and its use is inappropriate in any rejections of the pending claims.

See, e.g., *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly “hook” which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant’s endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a “catch” of unstated structure is such a concept, and why it would have made the claimed invention obvious.). See also, MPEP §2141.01(a).

Accordingly, Applicants respectfully assert that neither Sylvan nor Gerszberg, taken singly or in combination, disclose all of the limitations recited in independent Claims 1 and 14. Moreover, assuming *arguendo* that Gerszberg even discloses the limitations relating to DSL in Claims 1 and 14 for which the Examiner relied, such limitations cannot be shown in Gerszberg because Gerszberg is non-analogous art and, thus, cannot be combined with Sylvan. Thus, Claims 1 and 14 are patentably distinct and nonobvious over the cited references for at least the reasons set forth above.

Claims 2-5, 8, and 9 depend either directly or indirectly from Claim 1 and, thus, contain all of the limitations of Claim 1. Claims 15-19 depend either directly or indirectly from Claim 14 and, thus, contain all of the limitations of Claim 14. Thus, Claims 2-5, 8, and 9 and Claims 15-19 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claims 1 and 14, respectively. Reconsideration of the rejection is respectfully requested.

Claims 6, 7, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sylvan as modified by Gerzberg as applied to Claims 1-5, 8, 9, 14-19 above, and further in view of Desmond et al. (hereinafter “Desmond”).

Claims 6 and 7 depend from Claim 1 and, thus, contain all of the limitations of Claim 1. Claims 20 and 21 depend from Claim 14 and, thus, contain all of the limitations of Claim 14. Thus, Claims 6 and 7 and Claims 20 and 21 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claims 1 and 14, respectively. Reconsideration of the rejection is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of November 26, 2003 be withdrawn, that pending claims 1-21 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's Deposit Account No. 07-0832.

Respectfully submitted,

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